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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,389	01/08/2001	Frank Addante	11032/3037	6110
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KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			DURAN, ARTHUR D	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/757,389

Applicant(s)

ADDANTE, FRANK

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Claims 13-25 have been examined.

Response to Amendment

2. The Amendment filed on 9/7/07 is sufficient to overcome the prior rejection. The Angles reference has been added to the rejection of the independent claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 13-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 13 and 25 state, "the redirect command configured to direct the user to the direct connect server". Examiner could not find any support in the Applicant's Specification for redirecting to the direct connect server. Hence, these features are unsupported. Hence, claims 13 and 25 are unsupported. And, claims 14-24 are dependent upon claim 13. Hence, claims 13-25 are unsupported.

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Election/Restrictions

4. Claim 1-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Election was made of Group II or claims 13-24 in the reply filed on 7/31/06.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/7/07 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (5,794,210) in view of Angles (5,933,811).

Claims 13, 25: Goldhaber discloses in a network system comprising a public network, a creative selection server connected to the public network, a content server, and a user computer

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that requests content pages over the public network and receives content pages

and redirect commands for one or more creatives from the content server:

a server system comprising:

a direct connect agent connected to public network separately from the creative selection server, wherein the direct connect server receives creative selection criteria from the user computer,

generates a request for creative message as a function of the creative selection criteria;

transmits the request for creative message to the creative selection server;

and receives an identification of one or more creatives from the creative selection server and sends the identification of the one or more creatives to the user computer (Figure 10; col 15, line 46-col 16, line 5).

Note in these figures and citations from Goldhaber that item 110/agent functions as the direct connect server and that item 106/attention brokerage server functions as the creative selection server. And, note that Goldhaber discloses that either the 110/agent or 106/attention brokerage server can perform the matching (col 15, line 46-col 16, line 5).

Goldhaber does not explicitly disclose that the agent/110 is a server. However, Goldhaber discloses that agents/110 can be separate from the consumer computer and that the agents can operate from anywhere in system 100 (Fig. 1), and that system 100 can include a variety of separate servers:

"(67) In this example, the consumer interest profiles 124 may be stored at consumer computers 104 and/or at attention brokerage servers 106. In either case, the consumer's interests are represented by one or more software agents 110 that stand in for the consumer even when the consumer's computer 104 is turned off. These software agents 110 can "live" anywhere in system 100 (col 14, lines 40-50);

(2) FIG. 1 shows an example of an overall environment 100 in which the

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present invention may be used. Environment 100 includes a network 102 such as, for example, the Internet or "Future Net." A plurality of consumer computers 104 are connected to network 102. Also, connected to network 102 are a plurality of information servers 106 and one or more financial clearinghouse computers 108. Network 102 allows each of computers 104, 106 and 108 to communicate with other computers" (col 9, lines 30-41).

Therefore, since Goldhaber's agent is separate and can function anywhere in system 100 and since system 100 includes numerous servers, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Goldhaber's agent can function on a separate server. One would have been motivated to do this in order to allow the agent better or more flexible processing capabilities.

Additionally, Examiner notes that Goldhaber discloses presenting a list of ads to the user and that the list can include titles (col 5, lines 25-35) and that the ad list can be negatively priced information where a different price is present for each ad on the list (col 7, lines 47-60; col 10, lines 38-57)

Goldhaber discloses tracking items seen by user and also indexing all content seen by users (col 8, lines 40-50).

Also, Goldhaber discloses that the user can view a title or cybercoin or thumbnail and that the full content that matches the title/cybercoin/thumbnail can be retrieved (col 16, lines 5-17).

Also, Goldhaber discloses creating an index for new ads and filing ads/ad indexes, retrieving the thumbnail/title/cybercoin of an ad when there is ad match, and then retrieving the full content of an ad when a user selects the thumbnail/title/cybercoin of an ad from an ad list (Figure 11a; col 16, lines 17-41).

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Hence, Goldhaber needs a way to retrieve the full content that matches with the thumbnail of the content.

Hence, Goldhaber implies uniquely identified ads because the ads must be identified for negative pricing purposes for each unique ad, also because of the titles/thumbnails/cybercoins for ads, also because of the indexing and list of ads, also because the titles/thumbnails/cybercoins that are selected by the user need to be uniquely matched with the full content of the ad. Hence, Goldhaber implies in numerous ways and disclosures receiving an identification of one or more ads from the item 106/attention brokerage server or receiving an identification of one or more ads.

Additionally, Goldhaber, whose priority dates is December, 11, 1995 discloses that it is obvious, old and well known that advertising can be sent or linked with the content that the user requested seeing:

“(10) Because of the lack of focus inherent in mass communication, today's print and television advertising uses the concept of "linked sponsorship." "Linked sponsorship" embeds ads within or accompany (sponsor) content most likely to reach the advertisers'target audience.” (Background of the Invention, col 2, lines 21-26).

Goldhaber further discloses that advertising can be sent or linked with the content that the user requested seeing (Figure 5 and below):

“(17) FIG. 5 illustrates the concept of "linked sponsorship," and FIG. 6 illustrates the concept of "orthogonal sponsorship." As explained above, the "linked sponsorship" model shown in FIG. 5 i s the traditional way in which

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advertisers 62 deliver their ads to consumers 64 via mass media providers 66.

In the FIG. 5 model, the advertisers 62 compensate the mass media providers 66 to include advertisements 68 embedded in the entertainment or other content 70 being distributed by mass media to consumers 64” (col 11, lines 59-67).

Goldhaber does not explicitly disclose utilizing banner ads, html, or redirects.

However, Angles discloses advertising accompanying or associated with the content requested, banner ads, html, and redirect commands (Figure 9; col 4, lines 5-16; col 6, lines 30-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Goldhaber’s obvious ads associated with content can also include banner ads and redirecting URLs/HTML commands. One would have been motivated to do this in order to better present advertising of interest to the user.

Claim 14: Goldhaber discloses the request for creative message of claim 13 further defined as a function of a stored profile (col 14, lines 40-67; col 15, line 56-col 16, line 62).

Claims 15, 16, 18, 20, 22:

The prior art discloses the above.

Goldhaber further discloses targeting the user based on a variety of user information both demographic and dynamic (throughout the Goldhaber disclosure). Goldhaber discloses targeting users based on location/geographic information (col 15, lines 16-21). Goldhaber further communicating with the consumer’s computer over the network or Internet (col 12, lines 14-28). Goldhaber further discloses uniquely identifying a user computer (col 16, lines 41-48).

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Goldhaber further discloses not including data from which the address of a user can be derived or that a user can remain anonymous/confidential (col 15, line 55-67; col 13, lines 50-55).

Goldhaber does not explicitly disclose utilizing IP address or domain information.

However, Angles discloses utilizing the IP address and the content provider as relevant communications information and utilizing the Internet Service provider of the user as relevant criteria for selection/targeting purposes (col 7, lines 10-26; col 9, lines 20-30; col 9, lines 35-45; col 10, lines 20-34 ; col 14, lines 15-26; col 16, lines 25-38; col 17, lines 3-10).

Angles further discloses that domain name of the content server can be a criteria (col 11, lines 17-26).

Also, it is old and well known that different Internet Service Providers are going to utilize different domain names.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that IP information of domain information can be utilized as a criteria in Goldhaber's targeting based on a range of criteria including preferences and geographic information. One would have been motivated to do this in order to utilize the preference and geographic information that domain names and IP addresses indicate.

Claim 17: Goldhaber discloses the request for creative message of claim 13 further defined as a function of whether or not the user computer has previously connected to the content server (Figs. 15, 12).

Claim 19: Goldhaber discloses the request for creative message of claim 13 further defined as a function of a search term entered by the user computer (Fig. 10, item 124).

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Claims 20, 22: Goldhaber discloses the request for creative message of claim 13 further defined as a function of IP address of the content server (Fig. 10, items 140(1), 140(2); col 15, lines 16-31). Note that different content servers can have different types of content. Hence, which content server to go to can be considered as part of the selection/matching. And, it is obvious that for the agent to go to a server over the Internet that the destination server must have an address that the agent can access. One would be motivated to use a domain name or IP address in order to provide a readily available way to go to the content server of interest.

Claim 21: Goldhaber discloses the request for creative message of claim 13 further defined as a function of whether or not the user computer has previously connected to the direct connect server (col 14, lines 58-67).

Claim 23: Goldhaber discloses the request for creative message of claim 13 further defined as a function of a meta tag on the content server (Fig. 10; col 15, lines 16-31).

Claim 24: Goldhaber discloses the direct connect server of claim 13 further comprising a lookup table for storing category codes for use in generating a request for creative message (col 15, lines 30-47).

Response to Arguments

7. Applicant's arguments with respect to the claims have been considered but moot in grounds of the rejection above. Please note the 35 112 Rejection above and the addition of Angles to the 35 SUC 103 rejection of the independent claims. Examiner further notes the following.

On page 5 of the Applicant's Remarks dated 9/7/07, Applicant states:

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“In contrast, Goldhaber does not describe generating a request for creative message in response to a user request as required by the claims. . .

Thus, each advertisement is sent to the user only in response to a user request to view the advertisement. There is no suggestion that the advertisements are sent to the user in response to a request for non-advertisement content and/or a redirect command as required by the claims. . .

Specifically, Angles does not teach or suggest a request for creative message generated in response to a user request to receive non-advertising content and at least one redirect command from a content server, where the redirect command is configured to direct the user to the direct connect server.”

However, Goldhaber, whose priority dates is December, 11, 1995 discloses that it is obvious, old and well known that advertising can be sent or linked with the content that the user requested seeing:

“(10) Because of the lack of focus inherent in mass communication, today's print and television advertising uses the concept of "linked sponsorship." "Linked sponsorship" embeds ads within or accompany (sponsor) content most likely to reach the advertisers'target audience.” (Background of the Invention, col 2, lines 21-26).

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However, Angles discloses advertising accompanying or associated with the content requested, banner ads, html, and redirect commands (Figure 9; col 4, lines 5-16; col 6, lines 30-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Goldhaber’s obvious ads associated with content can also include banner ads and redirecting URLs/HTML commands. One would have been motivated to do this in order to better present advertising of interest to the user.

The citations added preceding were also added to the 35 USC 103 rejection above.

Examiner further notes that it is the Applicant’s claims as stated in the Applicant’s claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where

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the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

And, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007).


Also, KSR states that it is obvious to recite combination which only unite old elements with no change in their respective functions and which yield predictable results. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Arthur Duran
Primary Examiner
Art Unit 3622

10/18/2007